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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,843	03/15/2005	Hirokazu Kitayama	576P070	1910
42754	7590	03/27/2006	EXAMINER	
NIELDS & LEMACK 176 EAST MAIN STREET, SUITE 7 WESTBORO, MA 01581			KLEMANSKI, HELENE G	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/527,843

Applicant(s)

KITAYAMA ET AL.

Examiner

Helene Klemanski

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/31/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The references cited in the Search Report dated December 10, 2002 have been considered.

Claim Objections

2. Claim 6 is objected to because of the following informalities: n claim 6, the term "Claims1" should be replaced with the phrase "Claims 1". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, the term "using" is indefinite. A "process" defined in the sole terms of "using" does not define patentable subject matter under 35 USC 101. See *In re Fong*, 129 U.S.P.Q. 264 (CCPA 1961). The examiner suggests the language "A method for ink-jet recording comprising ejecting ink composition droplets in response to record signals to record onto a recording material wherein the ink composition is the ink composition as claimed in claim 6."

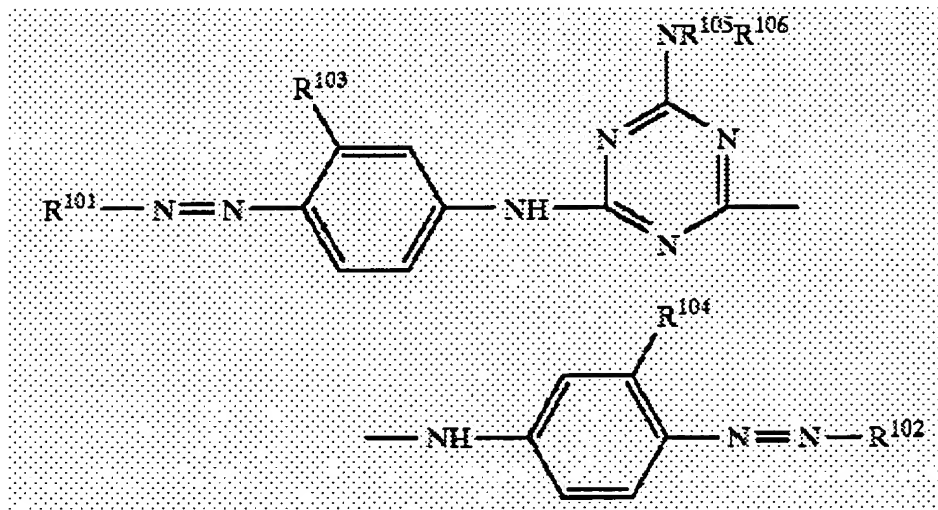
Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

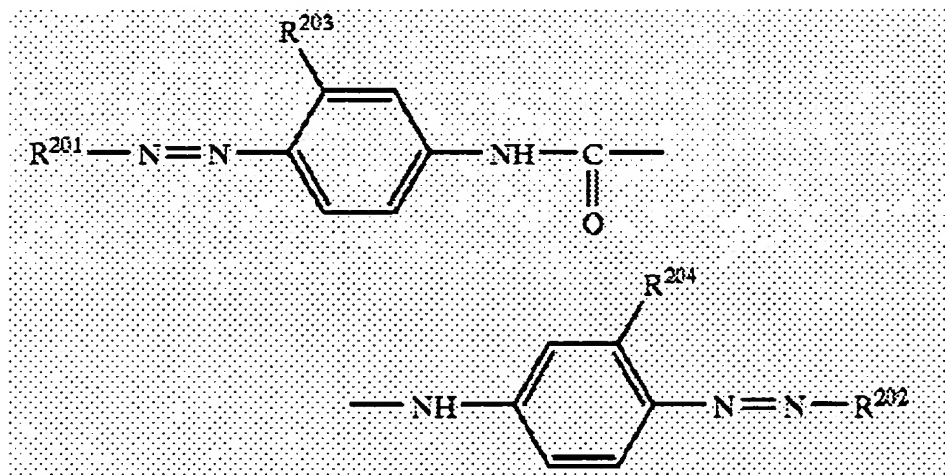
6. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al. (US 5,948,154).

Hayashi et al. teach a yellow ink composition comprising a dye of the formula (XI)



wherein R¹⁰¹ and R¹⁰² each independently represent phenyl or naphthyl substituted with a SO₃M group; R¹⁰³ and R¹⁰⁴ each independently represent H, alkyl or methoxy; R¹⁰⁵ and R¹⁰⁶ each independently represent H, hydroxyl or C₂H₄OH and M represents an alkali metal, ammonium or organic amine and a dye of the formula (XII)

Art Unit: 1755



wherein R^{201} and R^{202} each independently represent phenyl or naphthyl substituted with a substituent selected from the group consisting of OH, SO_3M or COOM group; R^{203} and R^{204} each independently represent H, alkyl or methoxy and M represents an alkali metal, ammonium or organic amine, water and a 15-35% by weight of a water-soluble organic solvent. The amount of each dye added is about 0.3-2.0% by weight and the dye represented by the above formula (XI) may be used as a mixture if two or more dyes of that formula. The ink has a pH of from 8.5-11. Hayashi et al. further teach an ink jet printing method comprising filling the print head of an ink jet printer and ejecting ink droplets onto a substrate such as paper. See col. 2, line 25 – col. 3, line 22, col. 6, lines 28-67, col. 7, lines 1-16, dye formulas (Y-1) and (Y-2), col. 9, lines 22-41, Table 1; example A2, col. 64, lines 59-60, Table 6; example C8, Table 8; example D8 and claims 1, 2 and 14-20. Hayashi et al. fail to specifically exemplify the use of a mixture of two dyes of the formula (XI) wherein both of the dyes contain sulfo groups on the substituents R^{101} and R^{102} .

Art Unit: 1755

Therefore, it would have been obvious to one having ordinary skill in the art to use the specific mixture of two dyes of the formula (XI) wherein both of the dyes contain sulfo groups on the substituents R^{101} and R^{102} as claimed by applicants as Hayashi et al. also discloses the use of these mixtures but fails to show an example incorporating them.

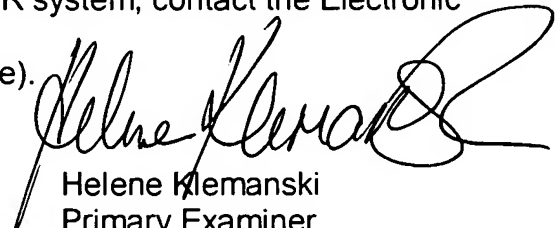
Conclusion

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Helene Klemanski
Primary Examiner
Art Unit 1755



HK
March 20, 2006